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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,713	11/13/2001	John Matthew Santosuosso	ROC920010222US1	6341

7590 08/04/2006

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EXAMINER

NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 08/04/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/007,713
Filing Date: November 13, 2001
Appellant(s): SANTOSUOSSO, JOHN MATTHEW

Gero G. McClellan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/15/2006 appealing from the Office action mailed 12/14/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 – 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 11 – 20 are not statutory, directed to a signal-bearing medium in which including wireless communications (See detail description). Claims 11 – 20 do not result in a physical transformation nor do they appear to provide a useful, concrete and tangible result. Claims 11 - 20 directed to software, per se, lacking storage a medium that enables any underlying functionality to occur. Therefore, claims 11 - 20 appear non-statutory.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20020143878	BIRNBAUM	10-2002
6,578,078	SMITH	06-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 – 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 11 – 20 are not statutory, directed to a signal-bearing medium in which including wireless communications (See detail description). Claims 11 – 20 do not result in a physical transformation nor do they appear to provide a useful, concrete and tangible result. Claims 11 - 20 directed to software, per se, lacking storage a medium that enables any underlying functionality to occur. Therefore, claims 11 - 20 appear non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birnbaum et al (U.S. 2002/0143878 A1) in view of Smith et al (U.S. 6,578,078).

◆ As per claim 11,

Birnbaum et al (U.S. 2002/0143878 A1) (herein Birnbaum) discloses a method, a signal bearing medium (Fig. 4, second computer), comprising a program which, when executed by a processor (Fig. 5, paragraph 0093), performs an operation for updating a database, the operation comprising:

- “Receiving a change request from a web browser, the change request indicating the web browser has detected a change related to a web page for which information is stored in the database” See Fig. 2A, paragraph 0056, 0064 – 0065, 0067 of Birnbaum.

Birnbaum does not clearly teach that:

- “Updating a database in response to receiving a change request from a browser”

Birnbaum only teaches that the system will be acted on the information depend upon the nature of the information (paragraph 0079 – 0080), but does not clearly teaches that the database is updated in response to the request.

Smith, however, on the other hand, discloses a method for update a web address in the server in response to a request comprising: “Updating a database in response to receiving a change request from a browser” (See Fig. 1, element 10, 26, col. 13 lines 1 – 10, col. 14 lines 8 – 17 of Smith).

In particular:

- “A change request” corresponds to the command from the author to move or delete a page.

- Because the author can use a computer as disclosed in Fig. 6, in which the author use a network connection to issue the command, therefore, the command is issued from a browser.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Smith into the invention of Birnbaum because the combination would provide an up-to-date database in response to a user request from a web browser.

◆ As per claim 1

Birnbaum et al (U.S. 2002/0143878 A1) (herein Birnbaum) discloses a method, a signal bearing medium (Fig. 4, second computer), comprising a program which, when executed by a processor (Fig. 5, paragraph 0093), performs an operation for updating a database, the operation comprising:

- “Monitoring operation of a web browser program to detect an event indicating a change involving a web page for which information is stored in the database” See Fig. 2A, paragraph 0056, 0064 – 0065, 0067 of Birnbaum.
- “In response to the detecting such an event, sending a notification to the database containing the information causing the information to be updated in accordance with the change” See Fig. 2A, element 104, paragraph 0056, 0064 – 0065, 0067 of Birnbaum

Birnbaum does not clearly teach that:

- “Updating a database in response to receiving a change request from a browser”

Birnbaum only teaches that the system will be acted on the information depend upon the nature of the information (paragraph 0079 – 0080), but does not clearly teaches that the database is updated in response to the request.

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Smith, however, on the other hand, discloses a method for update a web address in the server in response to a request comprising: “Updating a database in response to receiving a change request from a browser” (See Fig. 1, element 10, 26, col. 13 lines 1 – 10, col. 14 lines 8 – 17 of Smith).

In particular:

- “A change request” corresponds to the command from the author to move or delete a page.
- Because the author can use a computer as disclosed in Fig. 6, in which the author use a network connection to issue the command, therefore, the command is issued from a browser.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Smith into the invention of Birnbaum because the combination would provide an up-to-date database in response to a user request from a web browser.

◆ As per claims 2, 12, 25, the combination of Birnbaum and Smith disclose:

- “Verifying whether a data table in the database allows automatic updates before sending the notification” see col. 13 lines 19 – 21, col. 18 lines 35 – 37 of Smith.

◆ As per claims 3 – 4, 13 – 14, the combination of Birnbaum and Smith disclose:

- “Attaching the database to the web browser through a login process”. Because the computer used in Smith can be a network computer (col. 19 lines 1 – 19 of Smith), the database can be located in local or remote location. The user must use the network connection to connect with the database using the login process (col. 20 lines 7 – 19 of Smith). The system also provides an extra layer of security in order to gain access to the

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system or attach the database to the browser (See col. 5 lines 46 – col. 6 lines 10 of Smith).

- “ The browser resides on a client system and the database resides on a server system” See Fig. 6, col. 20 lines 20 – 33 of Smith.

◆ As per claims 5 – 7, 15 – 17, 26, 31, 35, the combination of Birnbaum and Smith disclose:

- “ The event comprises receiving, from a web server, a page redirect request to change a uniform resource locator (URL) or a web page from a first network address to a second network address” See Fig. 1, element 18 – 20, col. 13 lines 36 – 43 of Smith.
- Smith also discloses a table to store URL and update this table when a new data is entered (See col. 11 lines 49 – 63 of Smith).
- “ The first and second network addresses are utilized as links on a web page” See col. 13, lines 50 – 65 of Smith.

◆ As per claims 8 - 10, 18 – 20, 27 – 28, 32, 36, the combination of Birnbaum and Smith disclose:

- “ The event comprises a change in a web page” See Fig. 1, element 10 of Smith.
- “ The notification sent to the database contains sufficient information to update the database to reflect the change in the web page” col. 19 lines 1 – 19 of Smith.

◆ As per claims 21, 29 – 30, 33 – 34, the combination of Birnbaum and Smith disclose:

With all limitation as claimed in claims 11, 1, further claim 21 includes a memory contains a database management system comprising a database update program. The “database update program” corresponds to the “Referential Preservation engine Database” See the abstract.

Claim 29 further includes a “list of network addresses” See col. 11 line 49 – 63 of Smith.

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Further claim 29 includes: “automatically accessing each network address on a list of network address referenced in the database” See Fig. 4, col. 13, lines 30 – 50 of Smith.

♦ As per claims 22 - 23, the combination of Birnbaum and Smith disclose:

- “ A network connection configured to allow communication with the browser via the Internet” See Fig. 6 of Smith.

♦ As per claim 24, the combination of Birnbaum and Smith disclose:

- “ The database update program is part of a database server” See col. 19 line 1 – 8 of Smith.

(10) Response to Argument

In Appellant’s Brief, filed November 20, 2003, Appellant argues two specific points:

- 1) The Birnbaum reference does not describe receiving a change request from a web browser, the change request indicating the web browser has detected a change related to a web page for which information is stored in the database.
- 2) Information regarding a change in a web browser program is received from the mini-application, and not a web browser.

The Federal Circuit has embraced a theory of prima facie obviousness for use in ex parte prosecution in the PTO. The prima facie case is a procedural tool that, as used in patent examination, means not only that the evidence of the prior art would reasonably allow the conclusion that the examiner seeks, but also that the prior art compels such a conclusion if the Appellant produces no evidence or argument to rebut it. See *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). In the instant case, the prior art compels the conclusion that the

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claimed invention is unpatentable under 35 U.S.C. §103(a) as set forth in the Final Office Action, mailed December 14, 2005, and reiterated above for convenience.

Each of Appellant's two arguments above fails to rebut the *prima facie* showing of obviousness for the reasons discussed below.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 1:

Appellant's first argument is unpersuasive because Birnbaum clearly discloses: "receiving a change request from a web browser, the change request indicating the web browser has detected a change related to a web page for which information is stored in the database".

Referring to paragraph 0067, Birnbaum teaches that the information that detected can be new information entered by the user, new web address, information entered into a form by the user, etc. Information that entered by the user corresponds to the "change request" in the instant claim. Clearly, this information including information related to a web page because the user used a web browser to enter information (a web page address), a web page is displayed so the user can enter information. Therefore, the change that made by the user is related to a web page. As seen in Fig. 5, each computer has a memory to store information. In addition, in paragraph 0080, Birnbaum teaches that any change at the customer device will also occur at the agent browser, so the agent's browser will be synchronized to the customer browser. Therefore, the memory in the agent browser is represented as a "database" that can be used to store new information such as cookie or new information in its memory.

EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENT 2:

Appellant's second argument is unpersuasive because Birnbaum clearly discloses a web browser in the mini application program.

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In Fig. 4, Birnbaum discloses a web browser in each computing device, In Fig. 2A, information for a change is detected from a browser. Clearly, Birnbaum disclose “information regarding a change in the web browser program is received from a web browser”, as claimed in the instant application

According to paragraph 0080, each mini application uses a web browser when Birnbaum refers to “customer’s browser” and “agent’s browser”. Therefore, the information regarding a change in a web browser program is received from the web browser.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth

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in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.


Respectfully submitted,

Nguyen, Cam Linh

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below.

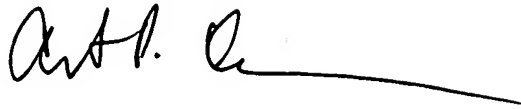
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